

REMARKS

Claims 1, 2, 4-9, and 11-17 are pending in this application. Claim 11 has been corrected, as requested by the Examiner. Reconsideration in view of the above amendment, the following remarks and Declaration Under R. 131 (concurrently filed with this Amendment), is respectfully requested.

The Office Action rejects, under 35 U.S.C. § 102(e), claims 1, 2, 4-9 and 11-17 over Wagner et al. (U.S. Patent Pub. No. 2003/0066092). This rejection is respectfully traversed.

Applicant respectfully submits that this rejection has been overcome by its submission of the concurrently filed executed Declaration Under R. 131 (Declaration).

More specifically, the Declaration executed by Mr. Kotzin, establishes conception of the subject matter of the present application in the United States or other provincial region permitted by Rule prior to the October 1, 2001 effective date of United States Application No. 2003/0066092 A1 entitled "Remote Task Scheduling For A Set Top Box" (Wagner Application) and establishes diligence of the filing of the present application (constructive reduction to practice) from a time prior to the October 1, 2001 effective date of the Wagner Application to the December 21, 2001 filing date of the instant patent application.

In support of the Declaration, Mr. Kotzin, declared and testified to the following. Please note, the excerpts below highlight many of the major points established in the Declaration. See the Declaration for the detailed wording.

1. THAT the claimed subject matter of the instant patent application was conceived in the United States permitted by Rule, before the October 1, 2001 effective date of the Wagner Application in the course of employment by Motorola Inc.

2. THAT the claimed subject matter of the instant patent application was the subject of a written invention disclosure (ID No. CS10398) duly prepared and submitted to a patent committee of Motorola Inc., for the purpose of documenting and evaluating invention disclosures for patent protection.

3. THAT the written invention disclosure (ID No. CS10398), attached as Exhibit A, is a true and accurate copy of the original written invention disclosure on which the instant patent application is based.

4. THAT the redacted conception date (permitted by the Commissioner for Patents pursuant to MPEP 715.07) on the attached written invention disclosure (ID No. CS10398), predates the October 1, 2001 effective date of the Wagner Application.

5. THAT, after consideration of the written invention disclosure, (ID No. CS10398), by a Motorola, Inc. patent committee, a patent specification and drawings were prepared by or on behalf of Motorola.

6. THAT the subject patent application was constructively reduced to practice, by virtue of the preparation and filing of a patent specification and drawings, which were duly reviewed, revised and filed, with diligence from a time prior to the October 1, 2001 effective date of the Wagner Application to the December 21, 2001 filing date of the instant patent application (Critical Period).

7. THAT, to the best of his belief, he exercised reasonable diligence during the Critical Period of the instant patent application.

8. THAT in the preparation of this paper, he personally examined Motorola's internal docketing system in connection with the Critical Period, and according to the system, he was an inventor on two additional new patent applications, which were filed on or about November 30, 2001 and December 7, 2001. They each required careful review of drafts, editing and consultation with the counsel preparing such applications, during the Critical Period.

9. THAT, in more detail, the patent application filed on or about November 30, 2001, was based on disclosure ID NO. CS10472. As background and context, it is noted that during the Critical Period, the World Trade Center terrorist bombings in New York (911), occurred September 11, 2001. According to these records, Mr. Kotzin was required by his management to work on a special assignment relative to communications handset altitude determination in multi-level environments. An engineering solution to this problem, could help first responders, such as paramedics, firemen and police, find and locate people trapped or calling for help at different altitudes (floors), in a building, such as in ones like the World Trade Center. This assignment was designated and confirmed as a high priority by Motorola management, as it could provide enhanced public safety. This assignment required a significant demand on my time during the Critical Period.

10. THAT, Mr. Kotzin personally examined other business records (Motorola Confidential Information), such as Motorola's internal disclosure submission system (eIntelligence), pertaining to the Critical Period. According to eIntelligence records, he submitted over ten new invention disclosures in key areas of innovation or strategic technology areas, between October 11, 2001 and November 22, 2001. He was the primary inventor on most of these invention disclosures, which required a significant investment of his time preparing the disclosures, preparing figures and revising them, for submission to a patent committee. Over fifty percent of these invention disclosures were determined to be pursued by a Motorola patent committee, for subsequent filing as US patent applications.

11. THAT, pertaining to the Critical Period, he also examined other business records (Motorola Confidential Information). According to such records, he was an active member and participant in, what was considered at the time, novel methods, systems and devices related to growing Gallium Arsenide on Silicon. He was an active member on a patent committee assigned to manage and grow the Intellectual Property portfolio, in connection with this breakthrough technology. During this period, Motorola invested and invented heavily in this high priority technology.

12. THAT, notwithstanding the many demands on his time as a senior technology leader, inventor and patent committee member, to the best of his ability and belief, he exercised or tried to exercise reasonable diligence, during the Critical Period, to facilitate the completion and filing of the instant patent application.

13. THAT all statements made in the Declaration were of his own knowledge were/are true and that all statements made on information and belief were/are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

In summary, it is respectfully submitted that Applicant has effectively sworn behind Wagner pursuant to R. 131. Therefore, Wagner does not qualify as a prior art reference under 35 U.S.C. § 102(e), by the proofs provided and established in Applicant's Declaration and under R. 131. Accordingly, Applicant respectfully requests withdrawal of the outstanding rejections.

In more detail, Applicant respectfully submits that independent claims 1, 8, 12 and 15 define patentable subject matter. The remaining claims depend from the allowable independent claims and therefore also define patentable subject matter. Accordingly, Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. § 102(e).

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1, 2, 4-9, and 11-17 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

The Commissioner is hereby authorized to deduct any fees arising as a result of this Amendment or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

Respectfully submitted,

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